

REMARKS/ARGUMENTS

According to the Office Action mailed January 20, 2004, the drawings are objected to under MPEP § 608.02(g) for failing to designate Figures 1 and 2 as prior art. The claims are objected to because the claim numbering is not in accordance with 37 CFR 1.126. Claim 7 is also objected to for an informality. Claim 10 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1, 5-7, 11-12, 15, 19, and 23 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,125,369 (Wu et al.). Claims 1, 12, and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,974,238 (Chase). Claims 2, 13, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu et al. in view of U.S. Patent No. 5,727,202 (Kucala). Claims 3, 14, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu et al. and Kucala, in view of U.S. Patent No. 5,230,073 (Gausmann et al.). Claims 8-9 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chase in view of U.S. Patent No. 6,212,553 (Lee et al.). Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chase and Lee et al. in view of U.S. Patent No. 5,943,676 (Boothby). Claim 2 is also rejected under 35 U.S.C. § 103(a) as being unpatentable over Chase in view of Kucala. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chase and Kucala in view of Lee et al. Claims 16-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu et al. and Kucala in view of U.S. Patent No. 6,052,735 (Ulrich et al.). Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu et al., Kucala, and Ulrich et al. in view of Gausmann et al. Figures 1 and

2 have been amended. Claims 7, 10, 12, 13, 16, 17, 19, 20, 22, and 23 have been amended.

Applicants respectfully request reconsideration and allowance of all pending claims.

I. Objection to Drawings Under MPEP § 608.02(g)

Figures 1 and 2 were objected to for failing to be designated by a legend such as "Prior Art". Figures 1 and 2 have been amended to designate the drawings as Prior Art and the amended drawings are attached as an Appendix after page 17.

II. Claim Objections

1.) The claims were objected to because the numbering of the claims is not in accordance with 37 CFR 1.126. Misnumbered Claim 22 has been renumbered to read Claim 23. Applicants thank the Examiner for correcting the claim numbering. The claim numbering above in the list of claims beginning on page 2 reflects the Examiners change of the misnumbered claim to read Claim 23.

2.) Claim 7 is also objected to because of an informality where a comma is missing. Claim 7 has been amended to correct the informality. Reconsideration of Claim 7 is respectfully requested.

III. Rejections Under 35 U.S.C. § 112

Claim 10 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as

the invention. Claim 10 has been amended. Reconsideration of Claim 10 is respectfully requested.

IV. Rejections Under 35 U.S.C. § 102

1.) Claims 1, 5-7, 11-12, 15, 19, and 23 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,125,369 (Wu et al.). Applicants respectfully disagree as described below.

With regard to Claim 1, Claim 1 recites, "a) designating at least one property of the first data object as a mergeable property and at least one corresponding property of the second data object as a corresponding mergeable property" and "b) determining if the conflict detected comprises a difference between the at least one mergeable property of the first data object and the at least one corresponding mergeable property of the second data object". Contrary to the statements of the Office Action, Wu et al. does not disclose these limitations. In fact, Wu et al. does not include any recitation of a mergeable property associated with a data object. Wu et al. instead discloses a method for prompting the user to resolve a conflict, which does not take into consideration mergeable properties. (Wu et al. col. 11, ln. 66 - col. 12, ln. 39) In contrast, the claimed invention determines whether the conflict is associated with mergeable properties of the conflicting data objects, and resolves the conflict when this is the case. (see Specification p. 15, lns. 10-20) Accordingly, since Wu et al. does not include all of the recited limitations of Claim 1, Wu et al. does not anticipate Claim 1.

With regard to Claims 5-7 and 11, Claims 5-7 and 11 are dependent upon Claim 1. Claims 5-7 and 11 are therefore not anticipated by Wu et al. for at least the reasons stated above with regard to Claim 1.

With regard to Claim 12, amended Claim 12 recites, " if a mergeable property of the first data object differs from a corresponding mergeable property of the second data object, merging the mergeable property of the first data object with the corresponding mergeable property of the second data object." Similar to Claim 1, Claim 12 recites mergeable properties. As stated above, Wu et al. does not disclose the use of mergeable properties in resolving a conflict. Accordingly, since Wu et al. does not include all of the recited limitations of Claim 12, Wu et al. does not anticipate Claim 12.

With regard to Claim 15, Claim 15 is dependent upon Claim 12. Claim 15 is therefore not anticipated by Wu et al. for at least the reasons stated above with regard to Claim 12.

With regard to Claim 19, Claim 19 recites, "a server configured to detect a conflict between one of the data objects and the corresponding data object when a mergeable property of the data object is different than a corresponding mergeable property of the corresponding data object and to merge the mergeable property of the data object and the corresponding mergeable property if different." Again, similar to Claims 1 and 12, Claim 19 recites mergeable properties. As stated above with regard to Claims 1 and 12, Wu et al. does not disclose the use of mergeable properties in resolving a conflict. Accordingly, since Wu et al. does not include all of the recited limitations of Claim 19, Wu et al. does not anticipate Claim 19.

With regard to Claim 23, Claim 23 is dependent upon Claim 19. Claim 23 is therefore not anticipated by Wu et al. for at least the reasons stated above with regard to Claim 19.

2.) Claims 1, 12, and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,974,238 (Chase). Applicants respectfully disagree as described below.

As stated above, Claim 1 and amended Claims 12 and 19 include limitations directed to using mergeable properties for resolving a conflict between data objects during synchronization. Chase does disclose a synchronization process, but the most that Chase discloses about conflicts is to state that data on a handheld computer and data on a desktop may be modified on both computers. (Chase col. 11, lns. 20-23) Furthermore, Chase has absolutely no disclosure of mergeable properties, or using mergeable properties to resolve conflicts. The "tags" mentioned in Chase are cache tags, or blocks of dedicated RAM with encoded bits of information pertaining to the associated data. (Chase col. 12, lns. 40-43) These tags cannot be equated with the properties of the claimed invention. Accordingly, since Chase does not include all of the recited limitations of Claim 1 or amended Claims 12 and 19, Chase does not anticipate Claim 1 or amended Claims 12 and 19.

V. Rejections Under 35 U.S.C. § 103

1.) Claims 2, 13, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu et al. in view of U.S. Patent No. 5,727,202 (Kucala). Applicants address these references below.

Applicants respectfully request that the Wolf reference be disqualified under the provisions of 35 U.S.C. 103(c). 35 U.S.C. 103(c) states:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Wu et al. qualifies as prior art only under 35 U.S.C. 102(e). Wu et al. is assigned to the Microsoft Corporation of Redmond, Washington. (Wu et al., cover page) The claimed invention is also assigned to the Microsoft Corporation of Redmond, Washington. The assignment of the claimed invention to the Microsoft Corporation was recorded with the United States Patent and Trademark Office on June 27, 2001, and is recorded at reel/frame: 011971/0353. Accordingly, at the time the invention was made, the subject matter, and the claimed invention were subject to an obligation of assignment to the Microsoft Corporation of Redmond, Washington. Therefore, Wu et al. cannot preclude patentability of the claimed invention under the provisions of 35 U.S.C. 103(c) and is disqualified as a reference.

In light of the disqualification of Wu et al., Kucala alone is insufficient to render claims 2, 13, and 20 unpatentable, as it does not teach or suggest a number of the claim limitations provided in independent Claims 1, 12, and 19. Claims 2, 13, and 20 are dependent upon claims 1, 12, and 19 respectively, and are therefore also patentable over Kucala.

2.) Claims 3, 14, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu et al. and Kucala, in view of U.S. Patent No. 5,230,073 (Gausmann et al.).

Again, as in the above rejection, Wu et al. is a disqualified reference for rejection under 35 U.S.C. § 103. Kucala in view of Gausmann et al. by themselves are insufficient to render Claims 3, 14, and 21 unpatentable, as they do not teach or suggest a number of the claim limitations provided in independent Claims 1, 12, and 19. Claims 3, 14, and 21 are dependent upon Claims 1, 12, and 19 respectively, and are therefore also patentable over Kucala in view of Gausmann et al..

3.) Claims 8-9 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chase in view of U.S. Patent No. 6,212,553 (Lee et al.).

Similar to the disqualification of Wu et al. above, Lee et al. is also disqualified as a reference for rejections under 35 U.S.C. § 103. Lee et al. qualifies as prior art only under 35 U.S.C. 102(e). Lee et al. is assigned to the Microsoft Corporation of Redmond, Washington. (Lee et al., cover page) Accordingly, at the time the invention was made, the subject matter, and the claimed invention were subject to an obligation of assignment to the Microsoft Corporation of Redmond, Washington. Therefore, Lee et al. cannot preclude patentability of the claimed invention under the provisions of 35 U.S.C. 103(c) and is disqualified as a reference.

As stated in the Office Action, Chase does not teach or suggest all of the limitations recited in Claims 8-9 and 22. Chase alone is therefore insufficient to render Claims 8-9 and 22 unpatentable. Claims 8-9 and 22 are therefore patentable over Chase.

4.) Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chase and Lee et al. in view of U.S. Patent No. 5,943,676 (Boothby).

As stated in the previous rejection, Lee et al. is disqualified as a reference for rejections under 35 U.S.C. § 103. Chase in view of Boothby by themselves are insufficient to render Claim 10 unpatentable, as it was previously stated that Chase does not teach or suggest a number of the claim limitations provided in independent Claim 1, and the addition of Boothby does not correct this deficiency. Claim 10 is dependent upon Claim 1, and is therefore also patentable over Chase in view of Boothby.

5.) Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chase in view of Kucala.

Claim 2 is dependent upon Claim 1. Claim 1 includes recitation directed to mergeable properties. Chase does not teach or suggest the use of mergeable properties, and the addition of Kucala does not correct this deficiency. Claim 2 is therefore also patentable over Chase in view of Boothby.

6.) Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chase and Kucala in view of Lee et al.

As previously stated, Lee et al. is disqualified as a reference for rejections under 35 U.S.C. § 103. As stated in the Office Action, Chase and Kucala do not teach or suggest all of the limitations recited in Claim 4. Chase and Kucala by themselves are therefore insufficient to render Claim 4 unpatentable. Claim 4 is therefore patentable over Chase and Kucala.

7.) Claims 16-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu et al. and Kucala in view of Ulrich et al.

As previously stated, Wu et al. is disqualified as a reference for rejections under 35 U.S.C. § 103. Kucala in view of Ulrich et al. by themselves are insufficient to render Claims 16-17 unpatentable, as they do not teach or suggest a number of the claim limitations provided in independent Claim 12. Claims 16-17 are dependent upon Claim 12, and are therefore also patentable over Kucala in view of Ulrich et al.

8.) Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu et al., Kucala and Ulrich et al. in view of Gausmann et al.

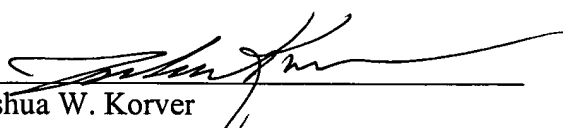
As previously stated, Wu et al. is disqualified as a reference for rejections under 35 U.S.C. § 103. Kucala and Ulrich et al. in view of Gausmann et al. by themselves are insufficient to render Claim 18 unpatentable, as they do not teach or suggest a number of the claim limitations provided in independent Claim 12. Claim 18 is dependent upon Claim 12, and is therefore also patentable over Kucala in view of Ulrich et al.

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the Applicants at the telephone number provided below.

App. No. 09/892,676
Amendment Dated: April 13, 2004
Reply to Office Action of January 20, 2004

Respectfully submitted,

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